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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Wolfgang Theimer

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5458

4955

7590

10/14/2010

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EXAMINER

MEI, XU

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

10/14/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/519,810	Applicant(s) THEIMER ET AL.	
	Examiner Xu Mei	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the applicant's response dated 07/26/2010.

Election/Restrictions

2. Applicant's election with traverse of invention I in the reply filed on 07/26/2010 is acknowledged. The traversal is on the ground(s) that the restricted two sets of claims are nearly identical. This is found persuasive and the previous restriction is withdrawn. All the claims (claims 1-27) are therefore considered in this office action.

Claim Objections

3. Claim 11 is objected to because of the following informalities: claim 11 is missing a "period" at the end of the sentence. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 22-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 22-27 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent and recent Federal Circuit decisions indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither transforms underlying subject matter nor positively ties to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process.

Re claims 22-24, the claimed method for reproducing stored multi-track reproduction data in accordance with predetermined conditions are interpreted as a series of steps completely performed mentally, verbally or without a machine, recalling *In re Bilski*.

Re claims 25-27, the claims are directed to non-statutory subject matter because they recited merely software tool comprising program code means, computer program comprising program code means, or computer program product comprising program code means (i.e., computer program code).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ka-wah et al (US-6,792,243, hereafter, Ka-wah) in view of Froeber et al (US-5,991,594, hereafter, Froeber).

Regarding claims 1, 8, and 22, Ka-wah discloses mass storage or an electronic reproduction device or method thereof (see Fig. 1), comprising a multi-track reproducer (visual and audible indicia), for reproducing stored multi-track reproduction data wherein said tracks have different kinds of data content (text, visual, and audio content data), characterized by a component to adapt the reproduction of a subset of said tracks to predetermined conditions (turning page for the reproducer, for example), said adaptation component being connected to said reproducer, and being adapted to operate a seamless change of the reproduction between two tracks or different tracks. What's not taught by Ka-wah is the tracks having synchronization markers. Froeber discloses an electronic book (see Figs. 1 and 3) in the same field of endeavor including different kinds of data contents such as text and it's corresponding audio signal, and different flags (synchronization markers) located within the text for the corresponding audio signal reproduction synchronization (see col. 5, line 45-col. 6, line 13). It would have been obvious to one of ordinary skill in the art to modify the different kinds of data within the mass storage or an electronic reproduction device of Ka-wah by different flags (synchronization markers) for the different data such as text and it's corresponding

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audio signal, as taught by Froeber in order to have an improved mass storage or electronic reproduction device that is adapted to provide smooth and seamless data synchronization among the different stored data such as text and its corresponding audio signal.

Regarding claims 2-7, and 23, it would have been obvious to one of ordinary skill in the art to modify the different flags or synchronization markers taught by Froeber with different properties as claimed in order to provide better and smoother data synchronization control between the text data and their corresponding audio signal.

Regarding claims 9-10, both Ka-wah and Froeber disclose the adaptation of automatically changing the tracks during reproduction when user is selected to read or play different pages of the mass storage or an electronic reproduction device.

Regarding claims 11-17, and 24, Ka-wah discloses the different switching control for the mass storage or an electronic reproduction device as shown in Fig. 1. It would have been obvious to one of ordinary skill in the art to modify the switching control of Ka-wah with different types of sensor in order to allow user have better and improve control for the different operations of the mass storage or electronic reproduction device.

Regarding claims 18-19, see Fig. 1 of Froeber, for example.

Regarding claims 20-21 and 25-27, the mass storage or electronic reproduction device of Ka-wah and Froeber is a built in communication device. It would have been obvious to one of ordinary skill in the art to modify or connect the device to a network or

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mobile terminal device for the purpose of allowing user conveniently have wireless and portable function for the mass storage or electronic reproduction device.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lane et al, Alon et la, Pennock et al are cited as pertinent art to the instant claimed invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xu Mei whose telephone number is 571-272-7523. The examiner can normally be reached on maxi flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 571-272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Xu Mei/
Primary Examiner, Art Unit 2614
10/09/2010